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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,597	12/19/2001	Yuji Suzuki	45939/VGG/H320	1261
23363	7590	12/12/2003	EXAMINER	
CHRISTIE, PARKER & HALE, LLP 350 WEST COLORADO BOULEVARD SUITE 500 PASADENA, CA 91105			LOCKER, HOWARD J	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER NUMBER

1208

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on September 22, 2003

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ ~~Claim(s)~~ The claim is ~~is/are~~ pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ ~~Claim(s)~~ The claim remains ~~is/are~~ rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

1. The following is a quotation of section (a) of 37 CFR 1.163:

"(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered."

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor in carrying out his invention."

In plant applications filed under 36 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

"No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention."

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

“The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.”

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish same from related, known varieties, and antecedents.

A: Responsive to paragraph 1A of the previous Office action, applicant has properly amended the statement relative to origin of the plant at page 1, but objectionable and conflicting language is present/remains at page 4, line 21, wherein origin is stated as “from the species”. Such should obviously be changed so as to recite origin consistent with that at page 1 of the specification.

B. Applicant has not imported into the specification additional information per 1B of the previous Office action. Instead, applicant has now deleted the information previously present at page 5 of the specification which at least discussed the age and culture of the plants for which color designations were set forth in the specification. Correction and/or clarification is necessary. Such information must be imported into the specification so as to lend meaning to the height and width values currently set forth in

the specification. At present, it cannot be determined if such are intended as representing values for the mature plant or something else. The specification should set forth the relative growth rate of the plant, as well as reciting mature height and spread therefor – at least to the extent and time the plant has been in cultivation and systematically observed.

C. In 1F of the previous Office action, objection to the petal ground color designation is set forth. Responsive thereto, applicant deleted the generic color description, but kept the color designation itself. Such remains objected to as it does not reasonably correspond to the plant as illustrated. Specifically, the bloom illustrated appears to be predominately yellow, with small areas of lighter yellow or greyed-green (the latter two appear to be adequately accounted for in the specification).

While such does not appear to be the case from the record at present, should the source of the noted discrepancy be the submitted photographic illustration, it would be necessary for applicant to file a substitute therefor (see 37 CFR 1.165(a) and 1.165(b)). Two copies of such would need to be furnished.

If the source of the noted error/discrepancy lies in the petal ground color designation set forth in the specification, it would be necessary for applicant to amend the specification, claim, and abstract as necessary to assure that the written description of the plant reasonably corresponds to the plant as illustrated, as so that all of same faithfully set forth/depict the true and characteristic features of the plant for which United Stated Plant Patent protection is being sought.

D. Applicant has amended the generic petal coloration to state that such are "white and greyed-green striped". Such is obviously in error for the reasons advanced in "C" above, as well as the fact there are no white areas in evidence in the submitted illustration, nor are there any petal color designations set forth in the specification that correspond to white. Additionally, that the petal is "striped" as indicated in the specification is not borne out by the petals illustrated. Correction and/or clarification is necessary. The specification must reasonably correspond to the plant as illustrated, and both must faithfully set forth/depict the true and characteristic botanical features of the plant.

E. At page 8 of the specification "Androecium" appears with nothing following it. While it appears that such was intended as a heading with indents there under, it is noted that "Stamens" etc. is not in fact indented there under. Correction and/or clarification is necessary. Applicant should thoroughly review the specification and provide appropriate correction throughout in this regard.

2. The claim remains rejected under 35 U.S.C. 112, first and second paragraphs, as not being supported by a clear and complete botanical description of the plant, for the reasons advanced in paragraph 1 above.

In addition, the claim should be amended so as to be directed to the new variety of plant as described and illustrated. It is suggested that the claim be amended to read "A new variety of *Kerria japonica* plant substantially as described and illustrated herein."

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Applicant is advised of the new mandatory procedures for amending the specification and claim under 37 CFR 1.121. Applicant may review same on the internet at the following site:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

5. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patents must now be addressed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

For further information regarding the new address, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

6. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campbell, can be reached at 703-308-4205.


Any inquiry of a general nature or relating to the status of this application should be directed to the TC 1600 receptionist whose telephone number is 703-308-0196.



## **TELECOPY/FACSIMILE TRANSMISSION**

Papers related to this application may be submitted to TC 1600 by facsimile transmission. Papers should be faxed to this TC via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The official fax number for TC 1600 is 703-872-9306.

Howard J. Locker/hjl  
December 08, 2003

  
HOWARD J. LOCKER  
EXAMINER  
GROUP ART UNIT 1661